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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,144	04/07/2004	H. Thomas Graef	D-1238 R2	8941
28995	7590	03/06/2006		
RALPH E. JOCKE walker & jocke LPA 231 SOUTH BROADWAY MEDINA, OH 44256			EXAMINER NICHOLSON III, LESLIE AUGUST	
			ART UNIT	PAPER NUMBER
			3651	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/821,144	GRAEF ET AL.	
	Examiner	Art Unit	
	Leslie A. Nicholson III	3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments and Amendments

1. Due to amendments to the specification, all objections to the specification are hereby withdrawn.

Due to further explanation by the Applicant, all rejections under 35 USC 112 1st paragraph are hereby withdrawn.

Arguments regarding the 35 USC 112 2nd paragraph rejections of claims 2 and 4 have been considered, but are not persuasive. See ¶3.

The 35 USC 112 2nd paragraph rejection of claim 6 is hereby withdrawn.

Regarding arguments related to Graef (USP 4,494,747), using Applicant's own citation, rollers 44 are clearly driven in reverse when feed roller 28 is driven in the feeding direction. Furthermore, the Graef reference meets the added limitation of the first note engaged with the at least one picking member (28) (limitation (d)), as admitted by Applicant (P15/L8-10).

Regarding arguments related to Swartzendruber (USP 4,159,782), the reference does teach the claim recitation clearly shown in C4/L12-25, as was previously cited.

Regarding arguments related to Beskitt (USP 6,302,393), Applicant correctly noted the typographical error made in the first action on the merits. The picker member is element 178 and not 190. However, the reference clearly reads on step (a) of claim 1. Furthermore, the additional note is moved relative to the first note as is clearly stated in C13/L30-49, as was previously cited.

Applicant's arguments with respect to claims 24-27 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' allege that Graef USP 6,783,061 does not qualify as prior art to the recited invention, though, have not argued why this is so. The filing date of this reference (11/13/2001) is earlier than the earliest priority date claimed for Applicants' invention (10/18/2002). Why does this not qualify as prior art?

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

By the wording of claim 2, it appears as though the claim means to say that the at least one additional note is moved in the second direction more rapidly than the first note is moved in the second direction, while the first note moving in the second direction has not been positively recited.

Regarding claim 4, the limitation of the first note moving in the second direction is claimed as though it has been positively recited, although it has not. The limitation of this claim is the difference of time of movement of the second note relative to the first note, however, movement of the first note in the second direction has not been positively recited.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Graef USP 4,494,747.

Graef discloses a similar method comprising:

- a) picking a first note bounding a stack of notes (11A), from the stack with at least one picking member (28) engaged with the first note, wherein the picking causes the first note to move in a first direction toward at least one stripper member (C10/L60-65)
- b) engaging notes other than the first note with the at least one stripper member (44,47), wherein generally notes other than the first note are prevented from moving from the stack
- c) sensing with at least one sensor (48) before the first note has disengaged from the stack, that at least one additional note has moved with the first note from the stack past the at least one stripper member (44,47) (C9/L13-17)
- d) responsive to (c), moving the at least one additional note in a second direction opposed of the first direction relative to the first note while the first note is engaged with the at least one picking member (C11/L8-18, C12/L14-20)

Graef further discloses a similar method wherein (a) includes urging the first note to move in the first direction by moving at least one moving member that is in supporting connection with the stack (C7/L46-62) and wherein (d) includes urging the first note to move in the second direction through moving the at least one moving member in the second direction (C4/L59-62).

6. Claims 1-4 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Swartzendruber USP 4,159,782.

Regarding claim 1, Swartzendruber discloses a similar method comprising:

- a) picking a first note bounding a stack of notes (C), from the stack with at least one picking member engaged with the first note, wherein the picking causes the first note to move in a first direction toward at least one stripper member (fig.1)
- b) engaging notes other than the first note with the at least one stripper member (44,46), wherein generally notes other than the first note are prevented from moving from the stack (C1/L57-65)
- c) sensing with at least one sensor (84) before the first note has disengaged from the stack, that at least one additional note has moved with the first note from the stack past the at least one stripper member (fig.1) (C4/L4-7)
- d) responsive to (c), moving the at least one additional note in a second direction opposed of the first direction relative to the first note while the first note is engaged with the at least one picking member(C4/L12-25)

Regarding claim 2, Swartzendruber discloses a similar method wherein (d) includes moving the at least one additional note in the second direction more rapidly than the first note (C4/L12-25).

Regarding claim 3, Swartzendruber discloses a similar method wherein (d) includes moving the at least one additional note in the second direction while the first note is held stationary (C4/L12-25).

Regarding claim 4, Swartzendruber discloses a similar method wherein (d) includes moving the at least one additional note in the second direction for a longer period of time than the first note is moved in the second direction (C4/L12-25).

7. Claims 1,7-10,14-21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Beskitt USP 6,302,393.

Regarding claim 1, Beskitt discloses a similar method comprising:

- a) picking a first note bounding a stack of notes (234), from the stack with at least one picking member (178) engaged with the first note, wherein the picking causes the first note to move in a first direction toward at least one stripper member (fig.14,27)
- b) engaging notes other than the first note with the at least one stripper member (194), wherein generally notes other than the first note are prevented from moving from the stack (C13/L20-48,64-67; C14/L1-40)

- c) sensing with at least one sensor (207) before the first note has disengaged from the stack, that at least one additional note has moved with the first note from the stack past the at least one stripper member (fig.14) (C13/L64-67)
- d) responsive to (c), moving the at least one additional note in a second direction opposed of the first direction relative to the first note while the first note is engaged with the at least one picking member(C4/L12-25)

Regarding claim 7, Beskitt discloses a similar method further comprising (e) determining if each first note moved from the stack has at least one characteristic associated with a valid note through operation of at least one validator device (38) (C6/L21-31) (fig.1).

Regarding claim 8, Beskitt discloses a similar method further comprising (f) moving notes determined to have the at least one characteristic of validity in (e), toward at least one first storage location (68) (C6/L32-59) (fig.1).

Regarding claim 9, Beskitt discloses a similar method further comprising (g) moving sheets determined as not having the at least one characteristic of validity in (e), toward at least one second storage location (70) (C6/L59-67) (fig.1).

Regarding claim 10, Beskitt discloses a similar method wherein in (g) the at least one second storage location is included in a module (10) with the at least one validator (fig.1).

Regarding claim 14, Beskitt discloses a similar method wherein (b) includes engaging notes other than the first note with at least one contact stripper member (194) and at least one non-contact stripper member (194') (C15/L65-67, fig.14,15).

Regarding claim 15, Beskitt discloses a similar method wherein (b) the at least one contact stripper member biasingly engages the at least one picking member (190) when no note extends therebetween (fig.15) (C13/L50-54).

Regarding claim 16, Beskitt discloses a similar method wherein (b) the at least one non-contact stripping member is disposed from the at least one picking member (fig.15).

Regarding claim 17, Beskitt discloses a similar method wherein the picking member includes an annular recess, and wherein the at least one non-contact stripper member extends in the at least one annular recess (fig.15), and wherein in (b) a cross sectional wave configuration is imparted to the first note (fig.15) (C13/L50-60).

Regarding claim 18, Beskitt discloses a similar method prior to (a) further comprising receiving the stack of notes in a chute (28), wherein the module includes the chute (C5/L46-52) (fig.1).

Regarding claim 19, Beskitt discloses a similar method prior to receiving the stack of notes in the chute, further comprising opening a gate bounding the chute wherein opening the gate enables the chute to receive the stack of notes (C5/L46-52) (fig.1).

Regarding claim 20, Beskitt discloses a similar method and prior to (a) further comprising receiving at least one input from a user through at least one input device of an automated banking machine, wherein the at least one input is operative to identify at least one of the user and an account (C5/L1-6), receiving the stack of notes into the

machine from the user, and wherein in (a) the first note is moved from the stack within the machine (C5/L45-63, C6/L20-31).

Regarding claim 21, Beskitt discloses a similar method further comprising determining whether each first note moved from the stack is a valid note through operation of at least one note validator device and crediting at least one of the user and the account a value associated with notes determined as having the at least one characteristic of validity in (e) (C4/L66-67, C5/L1-6, C6/L20-30).

Regarding claim 23, Beskitt discloses a similar method further comprising subsequent to (d), moving the first note in the first direction separately from another note (C14/L22-41).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beskitt USP 6,302,393 in view of Peters USP 5,267,826.

Regarding claim 11 and 12, Beskitt discloses all the limitations of the claim (see ¶7), but does not expressly disclose the method further comprising (h) dispensing notes from the automated banking machine, wherein the dispensing notes are removed from

the at least one storage location but does not expressly disclose the storage location within a chest portion

Peters teaches the storage location (102) within a chest portion (188) of an automated banking machine (fig.5) for the purpose of preventing unauthorized access to the at least one storage location.

At the time of invention it would have been obvious to one having ordinary skill in the art to locate at least one first storage location within a chest portion of an automated banking machine, as taught by Peters, in the method of Beskitt, for the purpose of preventing unauthorized access to the at least one storage location.

Regarding claim 13, Beskitt discloses a similar method wherein the notes dispensed in (h) include notes previously determined as having the at least one characteristic of validity in (e) (C6/L21-53).

10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beskitt USP 6,302,393 in view of Graef USP 6,783,061.

Beskitt discloses all the limitations of the claim (see ¶7), but does not expressly disclose the method of storing data in at least one data store correlating the user with notes not determined as valid (e).

Graef teaches a method of storing data in at least one data store correlating the user with notes not determined as valid in (e) (C15/L45-65) for the purpose of gathering evidence of attempted thievery.

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the method of storing data in at least one data store correlating the user with notes not determined as valid, as taught by Graef, in the method of Beskitt, for the purpose of gathering evidence of attempted thievery.

11. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beskitt USP 6,302,393 in view of Force USP 6,109,522.

Beskitt discloses all the limitations of the claim (see ¶7), but does not expressly disclose the step of moving a first note bounding a stack of notes input to the machine by a user or wherein (d) includes moving the first note and at least one note other than the first note in a second direction, wherein the at least one note other than the first note is moved in the second direction a distance greater than the first note is moved in the second direction.

Force teaches the step of moving a first note (188) bounding a stack of notes (146) input to the machine by a user for the purpose of identifying and storing sheets in the machine and later selectively dispensing to another customer (C1/L10-15).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the step of moving a first note bounding a stack of notes input to the machine by a user, as taught by Force, in the method of Beskitt, for the purpose of identifying and storing sheets in the machine and later selectively dispensing to another customer.

Force further teaches wherein (d) includes moving the first note and at least one note other than the first note in a second direction, wherein the at least one note other than the first note is moved in the second direction a distance greater than the first note is moved in the second direction (fig. 15, 16) (note: It is clear from the figures that the stack of notes leans towards the wall (170, 172), so as the notes finally separate, the note other than the first note will be farther from the wall and thus have moved a greater distance than the first note) for the purpose of preventing the sheet from moving too far and falling out of the stack (C16/L35-53).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the step of moving the first note and at least one note other than the first note in a second direction, wherein the at least one note other than the first note is moved in the second direction a distance greater than the first note is moved in the second direction, as taught by Force, in the method of Beskitt, for the purpose of preventing the sheet from moving too far and falling out of the stack.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3651

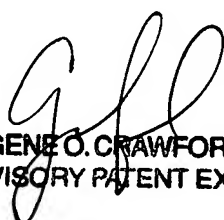
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

L.N.
2/27/2006


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SUPERVISORY PATENT EXAMINER